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Patent
Attorney's Docket No. 016800-473

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
	)	
Bruno MEHUL *et al.*	)	Group Art Unit: 1653
	)	
Application No.: 10/031,403	)	Examiner: Laurie A. Mayes
	)	
Filed: July 24, 2002	)	Confirmation No.: 2080
	)	
For: ISOLATED PEPTIDE OF THE HORNY LAYER AND USE THEREOF	)	

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Restriction Requirement set forth in the Official Communication mailed on February 12, 2003 (Paper No. 11), Applicants hereby elect **with traverse** the claims of Group I (Claims 1-20, and 25), which are drawn to protein, pharmaceutical and such methods of use.

The instant application is a national phase application of an International PCT Application. Therefore, 37 C.F.R. §§ 1.499, 1.475, 1.143 and 1.144 apply. Thus, unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. 37 C.F.R. § 1.475. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.* Thus, even if group of inventions is claimed, a restriction for

lack of unity of invention should not be made unless the claims lack the same or corresponding special technical features. The Office Action states that Groups I-V lack unity of invention. However, Applicants submit that Groups I-V contain the same or corresponding special technical feature of an isolated polypeptide from the family of calcium-fixing proteins.

Applicants further note that during review by the International Searching Authority (ISA), the claims of the PCT application did not receive a lack of unity rejection. Because unity of invention was found for the PCT application under PCT Rule 13, Applicants submit that the current restriction requirement is improper.

In Caterpiller Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590, 590-1 (E.D. Va 1986), the Court held that a restriction requirement of claims found to have unity runs afoul of Article 27. Article 27 provides in part:

> (1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Thus, analogous to the facts of Caterpiller, as this application was filed under 35 U.S.C. § 371 and the claims were found to have unity by the International Searching Authority, the U.S. Patent and Trademark Office cannot not now require a restriction. Requiring a restriction would run afoul of Article 27. Accordingly, Applicants request that the claims of Groups II-V be rejoined with the claims of Group I.

Finally, under U.S. patent law, an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner if the restriction is not required. M.P.E.P. § 803. As noted above, Groups I-V involve the same special technical feature. Furthermore, the Office has not set forth an explanation of how a search of the claimed invention would be burdensome. Thus, a serious burden would not be imposed on the Examiner to examine all the claims of Groups I-V in a single application. Thus, the restriction is improper and should appropriately be withdrawn.

Accordingly, for at least all of the reasons set forth above, withdrawal of the requirement for restriction is requested and believed to be in order. Further and favorable consideration of all the claims of record on the merits is respectfully requested

In the event that there are any questions relating to this Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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By: _____

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